

**Neifeld Docket No:** CAT/29US-SCROCO

Application/Patent No: 09/401,939

USPTO CONFIRMATION NO: 5333

File/Issue Date: 9/23/1999

Inventor/title: Scroggie/System and Method for Providing Shopping Aids and Incentives to Customers Through a Computer Network

Examiner/ArtUnit: Janvier/3688

37 CFR 1.181 PETITION TO WITHDRAW THE NOTIFICATION OF NON-COMPLIANT  
APPEAL BRIEF DATED MARCH 31, 2008

Sir:

In response to the Notification of Non-Compliant Appeal Brief dated March 31, 2008, the applicant traverses the requirement as improper and petitions the Director to reinstate the prior appeal brief.

**I. STATEMENT OF RELIEF REQUESTED**

The applicant petitions the Director to instruct the examiner to:

- (1) withdraw the requirement in the " Notification of Non-Compliant Appeal Brief dated March 31, 2008" to submit an amended appeal brief;
- (2) expunge the requirement to submit an amended appeal brief so that it does not detrimentally affect patent term adjustment;
- (3) expunge the replacement appeal brief submitted circa 4/10/2008;
- (4) reinstate the original appeal brief; and
- (5) specify in the decision that 37 CFR 1.704(c)(7) lost of Patent Term Adjustment (PTA) does not apply to the filing of the replacement appeal brief.

**II. STATEMENT OF MATERIAL FACTS**

1. On August 11, 2006, appellant filed an appeal brief that on page 15 stated that:

A voucher means "a document that provides supporting evidence for a claim, e.g. a receipt proving that a purchase was made." See for example:

<http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid=1861732375>.

2. On November 29, 2007, the Board of Patent Appeals and Interferences (Board) mailed an order returning undocketed appeal to examiner that on page 2 states that:

Finally, the Appeal Brief, received November 10, 2006, contains reference to a dictionary term that is technically considered to be evidence (see Appeal Br. 15). The dictionary term should be included along with a copy of said term in the Evidence Appendix Section of the Appeal Brief. *See MPEP* Section 1205.02.

The November 29, 2007 Board order on page 3 states that:

[Accordingly, it is Ordered that the application is returned to the Examiner] to instruct Appellants to file a Paper adding the abovementioned reference to the evidence Appendix.

3. On March 31, 2008, the examiner mailed a notification of non-compliant appeal brief. Check Box 10 in the Notice is checked, and no other check box is checked, indicating that the statement relating to check box 10 contains the only objection to the appeal brief.
4. The comment below check box 10 states that:

The Application was returned to the Examiner because the Appeal Center had concluded that the Appeal Brief contains a dictionary term that is technically considered to be evidence (See Appeal Brief page 15 and Section E related to the definition of a voucher). This dictionary term should be included along with a copy of said term in the Evidence Appendix Section of the said Appeal Brief (See MPEP 1205.02). Thus, the Appeal Brief is said to be defective. Positively, no other change, update or amendment is necessary or required at this time and hence, any other change to the existing Appeal Brief, unless otherwise approved by the Examiner, will be considered as a new issue and will not be entered.

That is the only objection to the brief specified in the Notice.

5. On April 9, my associate Bruce Margulies spoke with Examiner Janvier by telephone. Examiner Janvier gave his consent to the following changes to page 1 of the appeal brief to be filed in response to the pending notification of non-compliant appeal brief:

Update the title to "37 CFR 41.37 replacement appeal brief"

Update the description on page 1 of the brief to indicate what documents it is in response to, e.g. final office action..., appeal brief, examiner answer, reply brief, Notice, with the dates of each document since the final office action.

6. The applicant submits herewith the 37 CFR 1.17(h) fee for filing this petition.

### III. **REASONS WHY THE RELIEF REQUESTED SHOULD BE GRANTED**

Appellant traverses the notification of non-compliant appeal brief as improper, and

requests that the prior reply brief be reinstated. The requirement is improper for three reasons.

First, because content of arguments in briefs are not evidence, a requirement to provide items referenced in the brief in an evidence appendix is improper.

Second, citation to authorities is in the arguments section of the brief is expressly provided for in the rules. 37 CFR 41.37(b)(vii).

Third, since that evidence was not submitted during prosecution, inclusion in the Evidence appendix of the brief of that evidence would in fact be a violation of the pending rules for appeal briefs. 37 CFR 41.37(b)(ix) forbids presenting evidence not of record in the appendix. 37 CFR 41.33(c)(2) indicates that submission of new evidence after an appeal will probably result in automatic withdrawal of the appeal, since it would likely be treated as a request to reopen prosecution. The examiner cannot require the applicant to take action resulting in termination of an appeal in the guise of a requirement from the BPAI.

As to the BPAI panel, while the panel is free to discount or ignore suggestions that it consult authority on the meaning of words, such as dictionary definitions, it cannot reject an appeal merely because of that suggestion. In this case, the suggestion is to consider a dictionary definition in the statement in the brief, specifically:

“A voucher means ‘a document that provides supporting evidence for a claim, e.g. a receipt proving that a purchase was made.’ See for example:

[http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid=1861732375.](http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid=1861732375)”

Accordingly, the requirement should be withdrawn and the prior appeal brief reinstated.

Finally, this petition is not moot due to 37 CFR 1.704(c)(7). 37 CFR 1.704(c)(7) reduces PTA by the period between when a defective paper purporting to respond to an action was filed to the date a paper curing the defect was filed.

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|-----------------|--------------------------------|
| <u>4/9/2008</u> | Respectfully Submitted,        |
| DATE            | <u>/RichardNeifeld#35,299/</u> |
|                 | Richard A. Neifeld             |
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BTM/ran

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